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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,289	01/23/2002	Gavin Clarkson	017078.000003	7535
7590 Jackson Walker L.L.P. 112 E. Pecan Street Suite 2100 San Antonio, TX 78205			EXAMINER TINKLER, MURIEL S	
			ART UNIT 3691	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/12/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/055,289

Applicant(s)

CLARKSON, GAVIN

Examiner

Muriel Tinkler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

This application has been reviewed. The original claims 1-11 are pending. The rejections are as stated below.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1-<sup>4</sup> are rejected under 35 U.S.C. 102(a) as being anticipated by Hagelin (2002/0077835 A1).
3. Claims 1-4 disclose a method for calculating the optimum value of an intellectual asset comprising the steps of: a. determining the contribution to profit of intangible assets; b. deleting the contribution of assets other than intellectual assets from this contribution; c. deriving a base royalty rate from the difference.
  - Hagelin discloses calculating the optimal value of an intellectual asset in the abstract, page 1 and paragraphs 7-11 and page 2 and paragraphs 12-15.
  - Hagelin discloses determining the contribution to profit of intangible assets on page 2 and paragraph 20, page 1 and paragraph 8, page 3 and paragraph 40, page 5 and paragraph 60/61, page 9 and paragraph 97, and claim 2.

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- Hagelin discloses deleting the contribution of assets other than intellectual assets from this contribution on page 1 and paragraphs 9 and 11.
- Hagelin discloses deriving a base royalty rate from the difference on page 2 and paragraphs 19-20 and 23.

4. Claim 2 discloses the method of claim 1, wherein the contribution to profit of intangible assets is based on publicly available information or private company information. Hagelin discloses valuing intellectual property by the use of public and private data on page 1 and paragraphs 7-11.

5. Claim 3 discloses the method of claim 1, wherein the contribution to profit of intangible assets is based on an industry average (or median). Hagelin discloses the use of an industry average in the abstract, page 1 and paragraph 8, page 2 and paragraph 13, page 4 and paragraph 52,

6. Claim 4 discloses the method of claim 1, wherein the contribution to profit of intangible assets is calculated by first calculating the weighted average of cost of capital. Hagelin discloses the use of a weighted average of cost of capital on page 5 and paragraph 60, page 6 paragraph 64, and page 1 and paragraph 9.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagelin (US 2002/0077835 A1) in view of common knowledge.

9. Claim 5 discloses the method of claim 4, wherein the weighted average of cost of capital (WACC) is derived, using the following formula:  $WACC = E(R_i) + D(R_i) = R_f + \beta \cdot E(R_p) + i \cdot (1 - t)$  where  $E(R_i)$  = expected rate of return for equity investors  $D(R_i)$  = expected rate of return for debt investors  $R_f$  = risk free rate of return  $\beta$  = beta or systematic risk  $E(R_p)$  = expected risk premium  $i$  = interest rate on debt  $t$  = effective federal and state tax rate. Hagelin disclose the total weighted competitive advantage as the sum of the competitive advantage on page 5 and paragraph 54. Hagelin does not specifically disclose the use of a weighted average cost of capital, but does disclose the use of parameter groups with sub parameters, where the parameters groups are a sum of the sub-parameters on page 4 and paragraphs 44-53. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Hagelin to use Hagelin's format of a weighted average calculation and substitute

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the use of 'complimentary intellectual property assets' for the 'cost of capital' to obtain a repeatable and efficient way to obtain these values.

10. Claims 6-9 disclose the formulas pertaining to weighted averages for claim 5.

See the rejection for claim 5, particularly paragraph 46.

11. Claims 10 and 11 disclose the method of claim 1, wherein the contribution to profit of intellectual assets (CPIPIA) is calculated by subtracting the industry average (or median) distributor CPIA from the CPIA value for a given firm and from the average (or median) manufacturer CPIA value for a given industry. Paragraphs 8, 13, 52, 60, 64, 72 and 72, claim 11 and claim 20. Also so the rejections of claims 5-9.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Muriel Tinkler whose telephone number is (571)272-7976. The examiner can normally be reached on Monday through Friday from 7:30 AM until 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MT

February 2, 2007



HANI M. KAZIMI  
PRIMARY EXAMINER